

## REMARKS

## **I. Claim Status**

Claims 1-59 are currently pending in this application. Claims 6, and 8-59 have been withdrawn from consideration. Claims 5 and 7 were previously cancelled without prejudice or disclaimer. Claim 1 has been amended. Claims 1-4 are under examination.

## II. Formalities

The Examiner has withdrawn the rejection of the claims under 35 U.S.C. §112, first paragraph, in view of the amendments filed in the response of January 29, 2007.

Applicants thank the Examiner for entering the amendments and arguments from the response of January 29, 2007 in the present case and respectfully request reconsideration in view of the amendments and arguments presented herein.

## II. Amendments to the claims

Amended claim 1 recites that the plurality set of genes are full-length genes. Support for this amendment may be found throughout the specification and in particular on page 10, lines 10-11 and page 25, lines 4-7 of the specification, in Example 4 and Table IV, and in original claims 5 and 7.

Thus, it is believed that the present amendments are in compliance with 37 C.F.R. §1.116, since amended claim 1 incorporates the subject matter inherent in original claims 5 and 7 and require no additional searching by the Examiner. The amendments are believed to place the claims in condition for allowance. No new matter is added by way of these amendments.

### III. Rejections under 35 U.S.C. §102(b)

The rejection of claims 1-4 under 35 U.S.C. §102(b) as allegedly being anticipated by Ecker et al. U.S. Patent No. 5,747,253 (“Ecker”) has been maintained. The Examiner describes Ecker as teaching the use of all possible 8-mer DNA probes. The Examiner states that the instant specification describes a “gene” as including gene fragments that may or may not represent a functional domain. The Examiner concludes

that since the claims are not limited to isolated genes, that the 8-mer DNA probes of Ecker anticipate the claimed invention.

At the outset, Applicants note that Ecker's 8-mer phosphorothioate DNA probes are oligonucleotide analogs synthesized as random sequences and provide at best, a general teaching relating to the synthesis of DNA probes directed to no sequence in particular. (See, Ecker at Col. 16-20). The oligonucleotides and the process described in Ecker is in no way instructive with regard to a plurality of genes, much less a specific plurality of genes ABCC3, NTTT73, CYP7B1, BHMT, and SAHH, whether fragments or otherwise, that are differentially expressed in kidney cells in response to estrogen.

However, in order to expedite prosecution and without conceding the validity of the rejection, claim 1 has been amended to recite that the plurality set of genes are full-length genes. The specification clearly describes differential expression of groups of genes as being full-length genes. Support for the full-length nature of the specific genes recited in claim 1 may be found at least in the reference to the gene exemplar sequences and Unigene sequence references in Table IV of the specification.

Anticipation requires that each and every element of the rejected claim(s) be disclosed in a single prior art reference. See M.P.E.P. §2131 (8th Ed. Rev. 4, 2006). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element of the claimed invention must literally present, arranged as in the claim. *Perkin Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

Amended claim 1 recites a particular plurality of full length genes: the combination of all of full-length ABCC3, NTTT73, and CYP7B1 as the first group and; and full-length BHMT and SAHH, as the second group. The 8-mer random, DNA probes of Ecker do not teach the claimed plurality of full-length ABCC3, NTTT73, CYP7B1, BHMT and SAHH genes.

Since Ecker fails to teach all of the elements of the claims, Ecker cannot anticipate the present application. Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) under Ecker be withdrawn.

## CONCLUSION

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue. Applicants reserve the right to pursue the canceled and/or non-elected subject matter in one or more continuation or divisional applications.

If there are any other issues remaining, which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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